

REMARKS

Status of Claims

Claims 1-4 are pending. Claims 5-27 have been cancelled without prejudice and will be pursued in a divisional application. Claim 4 has been amended to correct informality in the claim language. No new matter has been added.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicants respectfully submit that the amendment made to claim 4 overcomes this rejection.

Rejection under 35 U.S.C. §§ 102/103

Claims 1-4 are rejected under 35 U.S.C. § 102(b), as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Watanabe (EP 0 831 119). Applicants respectfully traverse.

The Examiner concedes that Watanabe fails to disclose a gel fraction percentage (gel fraction dried weight/initial dried weight) of not less than 75% nor more than 95%. However, the Examiner asserts that Example 13 of Watanabe discloses the composition comprising 100 phr of polylactic acid and 3 phr of Funcryl FA-731A, and since the composition swelled in solvent, but cannot be dissolved, the Example 13 discloses that the composition has degree of crosslinking or a gel fraction close to 100%. Applicants respectfully disagree with the Examiner's characterization of the reference.

Applicants respectfully submit that as shown in Figs. 1 and 2 of the present application, when a mixture irradiated with ionizing radiation at 20-100kGy, the gel fraction percentage of the biodegradable aliphatic polyester is not less than 75% nor more than 95%. On the other hand, when the mixture is irradiated with ionizing radiation at less than 20 kGy, for instance, 10kGy, the gel fraction percentage is below 70%. In other words, simply using substantially the same composition (i.e. 100 phr of polylactic acid and 3 phr of Funcryl FA-731A) would not necessarily result in the gel fraction percentage of the biodegradable aliphatic polyester not less than 75% nor more than 95%.

In addition, the results of Example 13 of Watanabe that the composition swelled in solvent but cannot be dissolved does not necessarily disclose that the composition has degree of a gel fraction close to 100%. It is possible that the composition has degree of crosslinking or a gel fraction less than 75% because it swelled by absorbing the solvent. In this regards, the Examiner seems to rely on inherent disclosure of prior art.

However, Applicants respectfully note that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Applicants further note that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* See, MPEP § 2111. Applicants respectfully submit that the Examiner fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

To anticipate, every element and limitation of the claimed subject matter must be found in a single prior art reference, arranged as in the claims. *Brown v. 3M*, 265 F.3d. 1349, 60 USPQ2d 1375 (Fed. Cir. 2001). Further, in order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), all the claim limitations must be disclosed or suggested. At a minimum, the cited prior art does not disclose or suggest expressly or inherently the above recited limitation of claim 1. Therefore, Applicants respectfully request that rejection of claim 1 be withdrawn. In addition, since claims 2-4 are dependent claims upon claim 1, it is submitted that this claim is also allowable for at least the same reasons as claim 1.

Double Patenting

The Examiner provisionally rejected claims 1-4 on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-10 of pending Application No. 11/108,889. Specifically, the Examiner asserts that claims 1-4 of the instant Application and claims 1-10 of the pending Application No. 11/108,889 are not patentably distinct from each other. Applicants respectfully request that the rejection be held in abeyance until allowable subject matter is indicated in the present application.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Stephen A. Becker Reg. No. 51,321
to: Stephen A. Becker
Registration No. 26,527

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 SAB
Facsimile: 202.756.8087
Date: October 23, 2008

**Please recognize our Customer No. 20277
as our correspondence address.**